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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,232	02/28/2002	Leslie Dort	A889577US	7803

23971 7590 11/15/2005

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EXAMINER

BROWN, MICHAEL A

ART UNIT	PAPER NUMBER
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3764

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/084,232

Applicant(s)

DORT, LESLIE

Examiner

Michael Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39, 44 and 45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 and 44-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-19, 23-33, 36-39 and 44-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Scarberry.

Scarberry discloses in figures 1-4 a device for retaining a tongue comprising a single flange 12, having first and second surfaces (the inside and outside surfaces of 12), being sized and shaped to fit between a person lips and frontal surface of a person's teeth (fig. 1), the flange includes a protrusion 40, extending from the first surface to the second surface of the single flange (fig. 2), an aperture (indicated by 42), through the first and second surfaces and the single flange and the protrusion are an integrally molded one-piece body (col. 5, lines 5-10). The molded one-piece body is formed by molding (molded body, col. 5, lines 1-5). The aperture is adapted to receive the user's tongue (fig. 4). The integrally molded one-piece body is made of urethane (polyurethane (col. 5, lines 1-4). Claims 5-6 are intended use that Scarberry is capable of performing. The aperture includes walls (the walls of 40) that form a bulb 40 (as recited in claim 7). The bulb forms a vacuum (col. 7, lines 1-5). The walls form a

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smooth continuous surface (fig. 4) The proximal end of the aperture is radiused (fig. 4) and the distal end of the aperture is radiused (fig. 4). The flange and the bulb are an integrally molded one-piece body (col. 5, lines 5-10). Scarberry discloses a method or retaining a tongue forming a vacuum (using 40) with a tongue retention device 40, squeezing the walls (of 40), inserting a tongue (fig. 4), releasing the walls (of 40) and positioning a flange 12 between the user's lips and the front surface of the user's teeth (fig. 2).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-22, 34-35 and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scarberry.

Scarberry discloses in figures 1-4 a device for maintaining a user's tongue, substantially as claimed. However, Scarberry doesn't disclose what the thickness of the material is, the cross-section of the body having a constant thickness, the thickness of the flange or the device having instruction on how to use it. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the thickness of the material, the cross-section of the body having a constant thickness, the thickness of the flange or instructions on how to use the device are within the scope of the device disclosed by Scarberry. The thickness of the material and the

flange are not critical. Thus, those dimensions recited in the claim could be duplicated by Scarberry. The cross-section having a constant thickness is not critical. Thus, Scarberry could be formed with a constant thickness. It is extremely old and well known that any kit will have instructions. As for the adjustment of the flange it is old and well known to trim a flange of a mouthpiece in order to allow the mouthpiece to be custom fitted to the user. As for the type of molding used, no patentable weight was given to how the device was molded because each of the types of molding are old and well known in the mouthpiece art. Also the product and not how the product was formed was claimed. The flange is adjustable simply by moving it or trimming a portion off the edge.

### ***Conclusion***

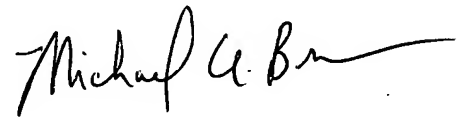
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brown whose telephone number is 571-272-4972. The examiner can normally be reached on 5:30 am-4:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gergory Huson can be reached on 571-272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Brown  
November 9, 2005

A handwritten signature in black ink, appearing to read "Michael A. Brown", with a long horizontal flourish extending to the right.

**MICHAEL A. BROWN**  
**PRIMARY EXAMINER**